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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,034	02/08/2002	Joseph Anthony Cornicelli	A0000417-01-CFP	3098

28880 7590 11/14/2003

WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR, MI 48105

EXAMINER

CRIARES, THEODORE J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/14/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,034

Applicant(s)

CORNICELLI ET AL.

Examiner

Theodore J. Criares

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/4/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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CLAIMS 1-30 ARE PRESENTED FOR EXAMINATION

Applicants response filed September 4, 2003 has been received and will be addressed in an action on the merits.

Applicant's election without traverse of Group I, the method of treating rheumatoid arthritis by administering a sulfonylaminocaronyl derivative in Paper No. 6, filed May 19, 2003, is acknowledged.

However, further restriction under 35 USC 121 is required to the following sulfonylaminocarbonyl derivatives:

- I. Parts of claim 1, derivatives classified in class 514, subclass 602 relating to compounds in U.S. Patents 5,633,287, 6,093,744 and 6,093,744.
- II. Parts of claim 1, derivatives classified in class 514, subclass 593 relating to compounds in U.S. Patent 5,288,757.
- III. Parts of claim 1, derivatives classified in class 514, subclass 490 relating to compounds in U.S. Patent 5,384,328.
- IV. Parts of claim 1, derivatives classified in class 514, subclass 605 relating to compounds in U.S. Patents 5,336,690 and 5,364,882.
- V. Parts of claim 1, derivatives classified in class 514, subclass 602 relating to compounds in U.S. Patents 5,633,287, and 6,093,744.
- VI. Parts of claim 1, derivatives classified in class 514, subclass 592 relating to compounds in U.S. Patents 5,254,589 and 5,981,595.

Inventions of Groups I-VI are unrelated since they have acquired a separate status in the pharmaceutical art as seen from their different classifications.

The active agents to be utilized in the practice of the elected invention, i.e., the treatment of rheumatoid arthritis, are classified throughout the various classes in the chemical art as set forth above.

It is clear that an undue burden will be placed on the examiner especially in the pharmaceutical literature in the examination of the claims. It is well established that the claims, as presented, claim subject matter which are separate and distinct in the pharmaceutical arts. Each of the agents claimed by applicant have well established different functions in the pharmaceutical art.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Further restriction may be required.

No telephone communication was made on this restriction requirement because the restriction is complex. (MPEP 812.01).

Applicant is required to elect a group and submit a claim for examination purposes which includes active agents which are capable of examination since the claims as present are not searchable as they claim a astronomical number of active agents.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

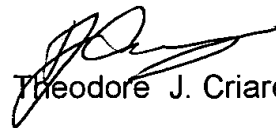
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is 308-

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4607. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is 703-746-6897.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.



Theodore J. Criares

Primary Examiner

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11/13/03

tjc